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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,606	08/16/2001	Ullrich Thiedig	64251-030	3007

7590 06/21/2006

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EXAMINER

PETERSON, KENNETH E

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/931,606	Applicant(s) THIEDIG ET AL.	
	Examiner Kenneth E. Peterson	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 32-43 is/are pending in the application.
 4a) Of the above claim(s) 1-5, 7-13 and 32-43 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 and 19 is/are allowed.
- 6) ☒ Claim(s) 6, 14, 15, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The amendment filed 19 May 06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

In claim 32, "a processor configured to adjust said cutting device" has no support in the specification as originally filed. The nearest subject matter that Examiner could identify was on lines 23-25 of page 8 of the specification, which stated that the advancing device is controlled.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. Newly submitted claims 32-43 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 32-43 recite "a processor configured to adjust said cutting device" whereas the originally examined claims are directed to a device where the advancing means (not the cutter) is controlled. The new claims and the original claims are related as species or possibly subcombinations usable together. It is hard to tell since there is no support for the new claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32-43 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Applicant has listed claim 15 as being withdrawn, but Examiner has never withdrawn this claim, and therefor it will be examined below.

3. Claims 15,17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The locations of the 1st,3rd and 4th regions of the tunnel are indefinite.

In claim 15, the boundaries of the 1st region is indiscernible. What are the boundaries of "a central region"? How is this different than the central region that is part of the 4th region in claim 18?

In claim 17, a 3rd region is recited, but not a 1st or 2nd region. Are the 1st and 2nd regions intended to be inferred?

In general, the "region" concept is fraught with ambiguities. It is not clear what would or would not infringe these "regions".

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 14, 15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cresson et al., U.S. patent 5,129,298, in view of Van Devanter et al., U.S. Patent 4,557,019, or Rudy et al., U.S. Patent 4,875,254.

Cresson discloses the invention substantially as claimed, including, e.g., a separating device (16); an advance device (1/2/3/4/25/6/7) for advancing the source towards the separating device; an optical detection device (9/13, see Figure 2) for determining the face area of the source body; a plurality of lamps (14, see Figure 2) for illuminating in a planar fashion along the longitudinal direction of the source such that the face and the surroundings of the face have an optical contrast; and wherein the optical detection device determines the area of the face by means of the said optical contrast and wherein the source body is advanced as a function of the measured face area.

Cresson lacks the tunnel for guiding the source body, wherein the tunnel includes an end adjacent the separating device and means for mounting the lamps in the tunnel. However, Rudy et al. and Van Devanter et al. both disclose that it is old and well known in the art to use tunnels for guide source bodies that include lamps mounting within and located adjacent cutting device for the purpose of minimizing the entrance of ambient light into the optical monitoring area such that the ambient light does not interfere with the optical equipment thereby increasing the accuracy of cut slices. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a tunnel with lamps mounted within and adjacent the cutting device in order to guide the source body based upon more accurate optical monitoring.

It should be noted that in apparatus claims, the work piece is not given any patentable weight, because it has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the orientation and shape of the workpiece could have a longitudinal direction (height) in the direction of the tunnel. Furthermore, it should be noted that the phrase "the tunnel having a length substantially aligned with the longitudinal direction" does not set forth what is the intended "length". The tunnels of Van Devanter et al. and Rudy both have tunnels with both vertical and horizontal dimensions, both of which could be considered a length.

As to claim 14, if it is argued that the modified device of Cresson lacks the reflective material for the tunnel, the examiner takes official notice (now taken as fact MPEP 2144.03) that it is old and well known in the art to use reflective material within lighted tunnels or enclosures for the purpose of increasing the light intensity within the tunnel or enclosure by preventing the walls of the tunnel or enclosure from absorbing the light. Therefore, it would have been obvious to one of ordinary skill in the art to use reflective material in the tunnel for the purpose of ensuring more light is directed to the work instead of being absorbed by the tunnel.

As to claim 15, the modified device of Cresson discloses a tunnel with a first region (the area closest to the cutter) in which the lamps deliver diffuse radiation with an intensity which is reduced towards the face because Cresson, Rudy et al. and Van

Devanter et al. all discloses lamps on opposite sides of the separating device.

Therefore, the light is at its most intense closer to the light and less near the separating device.

In regards to claim 17, the face of the tunnel near the cutter is considered to be a "cover", since that seems to be how Applicant is using the term as well.

As to claim 18, the modified device of Cresson discloses the need of having a lamp that directly shines on the advancing device (see Figure 2, the center lamp shines directly on the advancing portion (6)).

4. Claims 16 and 19 are allowed.

5. Applicant's arguments have been fully considered but they are not persuasive.

Applicant has overcome the 35 USC 112 rejection regarding the lamps to "deliver diffuse radiation with an intensity which is reduced towards the face". This is understood to mean that the face is backlit.

Applicant argues the 35 USC 103 rejection, noting that Cresson's lighting configuration is not the same as the current invention and thus does not provide the "overall" illumination that gets into the hollows. However, Applicant does not structurally claim this until claim 16 (the front light that shined rearwardly into the hollows), which Examiner has indicated as being allowable. Cresson is *capable* of providing sufficient lighting, especially for pieces of meat that have no hollows.

Applicant argues that Cresson uses a stop plate, has unacceptable inaccuracies, does not allow fast cutting, etc., but none of this changes the fact that Cresson, as modified, shows the claimed invention.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 571-272-4512. The examiner can normally be reached Mon-Thurs, 7:30AM-5PM

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KP
June 15, 2006



KENNETH E. PETERSON
PRIMARY EXAMINER